

REMARKS

Claims 17-30 are pending in this application. Claims 22, 23, 28 and 30 were amended to improve form. No new matter was introduced as a result of the amendments. Entry of the amendments, and favorable reconsideration is respectfully requested.

The Office Action indicated the priority was not granted with regard to PCT/EP03/13511, for not being submitted in the English language, and DE 10256455.8, DE 10339971, for not being certified copies. In response, Applicants attach an English-copy version of PCT/EP03/13511 (WO 2004/051502). Additionally, Applicants attach form PTO/SB/38, authorizing the office to electronically retrieve copies of the German patents per their respective EPO filing (EP1567942)(see, "Changes to Implement Priority Document Exchange Between Intellectual Property Offices," 72 FR 1664 (January 16,2007), 1315 Off. Gaz. Pat. Office 63 (Feb. 13,2007) (final rule) (hereinafter "Priority Document Exchange Final Rule"). Applicants note that these documents should have been forwarded to the USPTO per PCT Rule 17.2. If any issues remain with regard to the priority documents, Applicants kindly request the Examiner contact the undersigned to resolve any outstanding matters.

The Specification was objected to, claiming that the Abstract did not commence on a separate sheet in accordance with 37 C.F.R. §1.52(b)(4). Applicants note that, in the preliminary amendment dated June 3, 2005, the Abstract appears on a separate sheet (see page 11). Withdrawal of the objection is earnestly requested.

Claims 22 and 28 were rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. In light of the present amendments to claims 22 and 28, Applicants submit the objectionable matter has been addressed. Withdrawal of the rejection is earnestly requested.

Claims 17-30 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Wan* (US app 2004/0028049) in view of *Hunter* ("An Overview of the MPEG-7 Description Definition Language (DDL)"). Applicants respectfully traverse this rejection.

Regarding *Wan*, the reference discloses method for communicating at least part of a structure of a document (104) described by a hierarchical representation (102). The method identifies, via XML tags, the hierarchical representation (e.g., the tree structure) of the document

(104). The representation is then packetized (906) into a plurality of data packets. At least one link is then created (908) between a pair of the packets, the link acting to represent an interconnection between corresponding components (e.g., structure and content) of the representation (see Abstract; [0021]). As is evident from the entire disclosure of *Wan*, no provisions are made for dealing with complex data types or mixed content models. For example, in FIG. 1 (also illustrated in FIG. 9), the XML document (104) and the tree representation (102) can only support values that are directly connected to the elements (e.g., "Basketball" and <TD> 1.1, "Soccer" and <TD> 1.2, etc.). Indeed, *Wan* discloses that "[t]he structure is critical in providing the context for interpreting the text," since structure and text in an encoder allows the corresponding decoder to parse the structure of the document more quickly by processing only the relevant elements while ignoring elements (and descendants) that it does not know or require ([0047]).

Hunter provides an overview of the MPEG-7 Description Definition Language (DDL). Instead of providing specific teachings, the document merely tabulates notable features of DDL, along with a brief explanation (e.g., Attribute Declarations, Type Definitions, XML Schema Datatypes, etc.). Specifically, *Hunter* describes complex data types (S767) and mixed content type data (S768). Aside from providing examples of each data type, *Hunter* is completely silent with regard to implementations of each type - in fact, *Hunter* recognizes that "[i]ssues which still require resolution include such problems as . . . clarification, and location of MPEG-7 datatypes, data inheritance mechanisms, and the identification and handling of unused XML schema features. Another perceived problem is the instability of XML Schema" (VI. Current Status, pages 771-72).

Appellant submits that there is no apparent reason to combine *Wan* with *Hunter* in the manner suggested in the Office Action. Applicant respectfully submits that the Office Action has improperly piecemealed individual features from multiple references to arrive at the present rejection. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.* 550 U.S. ____ (2007) (slip op. at 14). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.

Cir. 1991). It is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments relying on *ex post* reasoning." *KSR v. Teleflex*, at 17.

It is recognized in the present application, that generating a binary representation of XML-based documents has disadvantages when it comes to the encoding of "complex type" data types with the "mixed" content model, because in addition to elements, the data types include textual contents which can only be reconstructed by the decoding of the entire data stream (see specification, page 1). In contrast, *Wan* only discloses tagging simple elements and teaches away from using the claimed features. In [0041-44], *Wan* expressly teaches that structure and text must be separated, so that elements and associated values are coded into two different streams or stream sections, if concatenated. *Wan* further discloses that the separation is "crucial" in order to allow "different and more efficient encoding methods [to be] applied to each of the structure and text" ([0046-47]).

The Office Action fails to reconcile how the descriptions in *Hunter* could conceivably be incorporated into the teaching of *Wan*. As Applicants have argued above, *Wan* appears to provide no capability for dealing with complex data types and mixed content, and further teaches away from using such a configuration. For at least these reasons, Applicants submit the rejection is improper and should be withdrawn.

In light of the above, Applicants respectfully submit that the present claims are allowable. An early Notice of Allowance is earnestly requested. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (112740-1080) on the account statement.

Respectfully submitted,

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